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No. 97-395

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1997

TANABE SEIYAKU CO., LTD.
AND MARION MERRELL DOW, INC.,

Petitioners,

v.

UNITED STATES INTERNATIONAL
TRADE COMMISSION,

Respondent,

-and-

ORION CORPORATION FERMION, COPLEY
PHARMACEUTICALS, INC., INTERCHEM
CORPORATION AND RHONE-POULENC RORER, INC.,

Intervenor-Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED FOR REVIEW

Question 1: Whether it is inappropriate for a patentee to use the doctrine of equivalents to completely read a meaningful limitation out of a patent claim or whether the public, relying on the statutory notice requirement for claims, is entitled to rely on that meaningful limitation in the claim, particularly where, as here, the patentee specifically excluded the element now sought to be recovered under the doctrine of equivalents.

LIST OF PARTIES PURSUANT TO RULES 14.1(b) AND 29.6

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Brief in Opposition to Petition for Writ of Certiorari, except Marion Merrell Dow, Inc. is now believed to be part of Hoechst Marion Roussell, Inc.

Respondents, Orion Corporation Fermion, Interchem Corporation and Rhone-Poulenc Rorer, Inc., do not have any subsidiaries. Orion Corporation Fermion is a division of Orion Corporation.

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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Respondents, Orion Corporation Fermion, Copley Pharmaceuticals, Inc., Interchem Corporation and Rhone-Poulenc Rorer, Inc. (collectively, the "Fermion respondents"), respectfully submit this Brief in Opposition to the Petition for a Writ of Certiorari of Tanabe Seiyaku Co., Ltd. and Marion Merrell Dow, Inc., (collectively "Tanabe/MMD" or "Petitioners").

Tanabe/MMD's petition is from a unanimous decision of a three judge panel of the United States Court of Appeals for the Federal Circuit and denial of a petition for rehearing and suggestion for rehearing in banc by that court. The Federal Circuit affirmed a determination by the International Trade Commission ("ITC") that there was no infringement of United States Patent No. 4,438,035 ("the '035 patent"), by the importation into this country of diltiazem hydrochloride made in Finland.

STATEMENT OF CASE

Respondents disagree with the Statement of the Case set out in the Petition for a Writ of Certiorari and hereby submit this Statement In Opposition.

1. In 1969, Tanabe's scientists discovered diltiazem hydrochloride, a pharmaceutical that has become widely used in treating cardiovascular diseases. Tanabe obtained U.S. Patent No. 3,562,257 ("the '257 patent"), which covered the diltiazem compound and disclosed a process that could be used to manufacture diltiazem. However, Tanabe did not use a process of manufacturing disclosed in, or based upon, the '257 patent to make bulk diltiazem hydrochloride. Rather, Tanabe used a trade secret process to manufacture bulk diltiazem hydrochloride in Japan. That diltiazem hydrochloride was sold in the United States to Marion Merrell Dow, Inc. ("MMD").

2. On December 1, 1982, after years of manufacturing and selling diltiazem made by using this trade secret process, Tanabe applied for a United States Patent for a very similar process. Tanabe did not tell the United States Patent and Trademark Office ("PTO") about its prior trade secret process or about the prior sales of material in the United States. The PTO granted Tanabe's new patent application and issued the '035 patent which is the patent at issue in the underlying proceeding.

3. In addition to the seventeen years of exclusivity provided for diltiazem hydrochloride on the basis of the '257 patent, MMD/Tanabe also received an additional four years of exclusivity from the United States Food and Drug Administration ("FDA") for the use of diltiazem hydrochloride marketed by MMD as Cardizem®. During this time period the market demand for diltiazem grew to more than a billion dollars per year.

4. To protect its exclusive market, upon the expiration of the four years of additional exclusivity, MMD/Tanabe sued every manufacturer and distributor of bulk diltiazem hydrochloride in the United States, regardless of what process was being used to manufacture that bulk diltiazem hydrochloride. Initially, MMD/Tanabe brought at least three separate district court actions. Subsequently, on February 25, 1993, Tanabe and MMD filed a Complaint with the International Trade Commission ("ITC") alleging that ten respondents including Orion Corporation Fermion, Interchem Corporation, Copley Pharmaceuticals, Inc., and Rhone Poulenc Rorer, Inc. (respondents here) had violated Section 337 of the

Tariff Act of 1930, as amended, 19 U.S.C. Section 1337 (a).[1] All of the district court proceedings were stayed in favor of the consolidated ITC proceeding.

5. After a year of discovery and two reexaminations before the PTO during which MMD/Tanabe again failed to disclose to the PTO the prior trade secret process, or the prior sales of the product made by that process, Administrative Law Judge Harris ("ALJ Harris") held in excess of a two-week hearing at which more than twenty witnesses, including ten experts, testified and thousands of exhibits were admitted. Following this hearing, ALJ Harris issued his Initial Determination ("ID") finding the '035 patent invalid as obvious over the prior art, unenforceable due to Tanabe's inequitable conduct before the PTO, and not infringed by any of the manufacturing respondents' processes including that of Fermion. [2] In the course of making his determination, ALJ Harris entered fifty-nine findings of fact under the heading "the Fermion Process," two hundred fifteen findings of fact related to the underlying science and to the patent claim at issue, three hundred thirty-six findings of fact related to the invalidity of the '035 patent and seventy-seven findings of fact related to the unenforceability of the '035 patent in view Tanabe's inequitable conduct.

6. After properly interpreting the claim, ALJ Harris concluded that because of its express language and in view of

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[1] MMD/Tanabe has settled with all but respondents here, paying those other respondents millions of dollars in exchange for their relinquishing certain antitrust counterclaims against MMD/Tanabe. Thus, footnote 1 in the Petition for Certiorari is disingeneous to the extent that it implies that the terms of the settlement were favorable to MMD/Tanabe.

[2] Fermion manufactures bulk diltiazem hydrochloride in Finland and that product is imported into the United States by Interchem. Copley was, and Rhone Poulenc Rorer is, a customer for Fermion's product.

the specification and file history of the '035 patent, claim 1 included only a very narrow range of equivalents which could not be broad enough to encompass the accused manufacturing processes of, *inter alia,* Fermion. That conclusion was proper.

7. On certification, the ITC issued a 10 page opinion analyzing and then adopting ALJ Harris' determination with respect to the non-infringement by the Fermion respondents. (See Petitioner's Appendix (hereinafter "Pet. App.") at 22-32. In light of that decision, the Commission found it unnecessary to address ALJ Harris' determination regarding the invalidity and the unenforceability of the '035 patent. Therefore, it left those findings undisturbed, taking no position on them.[3]

8. Subsequently, MMD/Tanabe appealed the determination of the ITC to the Federal Circuit. The Federal Circuit interpreted *de novo* the only claim at issue, claim 1, and determined *de novo* the appropriate scope of the claim under the doctrine of equivalents. It determined, as a matter of law, that whatever the range of equivalents, it could not cover the use of butanone, which was not an insubstantial difference, in the claimed process. It also agreed, based upon the appropriate substantial evidence standard for review, that the record provided no basis for overturning the ITC's factual determination that acetone and butanone were substantially

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[3] ALJ Harris had also imposed sanctions as alternative relief for petitioners' pattern of misconduct during discovery in the underlying proceeding. Those sanctions were set forth in Order No. 52 and were to be imposed only if the Commission determined, based on all of the evidence of record, that claim 1 of the '035 patent was infringed. Because the Commission agreed that there was no infringement, the imposition of sanctions against petitioners was vacated as moot. The Commission considered Order No. 52 to be part of the ID. Pet. App. at 25, note 2. Petitioners' nonetheless omitted it from their appendix although they included the remainder of the ID.

different.[4] For all these reasons, the lower court agreed that there was no infringement.

9. The lower court *did* examine the objective equivalence of the accused and properly construed claim elements at the time of the alleged infringement. (Pet. App. at 18). The petitioners' question 1 presupposes a nonexistent inconsistency between such an examination and the additional consideration of evidence of the specific exclusion from the claim of certain elements by the inventor. This was not the fact situation in *Warner-Jenkinson v. Hilton Davis Chemical Co.*, ___ U.S. ___, 117 S. Ct. 1040. Petitioners' question 1 is therefore flawed because of this unfounded presupposition and also because it erroneously characterizes the decision of the lower court. The lower court did apply the "substantial evidence" test to the determinations of fact by the ITC and concluded there was no basis for disturbing those determinations. Pet. App. at 18 .

10. Respondents also disagree with petitioners' question 2. First, *Warner-Jenkinson*, did not concern the doctrine of narrow claiming, where a patentee specifically excludes certain elements from the patent claim. Second, petitioners' question 2 is not supported by the record because the lower court specifically held that there was no objective equivalence between butanone and acetone Pet. App. at 17-18, and that those of skill in this art would not have considered there to be objective equivalence between the claimed and accused elements in this process. *Id.* Thus, the petitioners' question 2 presupposes a nonexistent objective equivalence. Nowhere did the lower court hold that "the doctrine of equivalents does not exist as a matter of law." Finally, there is no evidence in the record regarding what the "patentees' purpose" was in specifically excluding the accused element from the claim.

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[4] Respondents' therefore disagree with petitioners' footnote 3.

Thus, petitioners' question 2, like their question 1, raises hypothetical issues not actually present in this case.

REASONS FOR DENYING THE WRIT

Appeals from the circuit courts of appeal are heard by the Supreme Court *only* for compelling reasons. See Supreme Court Rule 10. No compelling reason exists for a review of the underlying decision by the Federal Circuit. Petitioners' questions for review present hypothetical issues and lack foundation in the record. When properly recast in the form of Respondents' question for review, the obvious answer to that question, which this Court provided in *Warner-Jenkinson*, is yes.

The lower court's decision is not in conflict with the decision of another United States court of appeals on the same subject. The lower court did not depart from the accepted and usual course of judicial proceedings so as to require the exercise of this Court's supervisory powers. The lower court did not decide an important federal question in a way that conflicts with relevant decisions of this Court. The lower court created no "new" law and made none of the errors attributed to it by petitioners. It did not ignore, and was fully aware of, the Court's decision in *Warner-Jenkinson*. It did not create a "new form of estoppel." It did not create, as a matter of law, any "counter-presumption" regarding the scope of the doctrine of equivalents. As petitioners recognize, it is the Federal Circuit that has been given initial responsibility to ensure national uniformity with respect to patent law questions such as this one. *Cf. Bonito Boats v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 162 (1989). The Federal Circuit's decision in this case promotes such uniformity.

Perhaps misunderstanding *Warner-Jenkinson*, petitioners seek to misapply that case to the present facts. The Court did not hold in that case that the *patentee's* intent is irrelevant to

the application of the doctrine of equivalents. The Court held that the accused *infringer's* intent is irrelevant. Indeed, *Warner-Jenkinson* explicitly held that the patentee's intent *was* relevant: "the better rule is to place the burden on the patent holder to *establish the reason for* an amendment required during prosecution." *Warner-Jenkinson*, 117 S. Ct. at 1051. "Establish the reason for" certainly includes "explain the intent of."

As a matter of law, according to the lower court, the permissible range of equivalents to which the patentee was entitled could not be broad enough to encompass butanone. The evidence was found to support the independent conclusion that "the reason" Tanabe presented a very narrow and specific claim to the PTO for examination was that those of skill in the art, including the inventors, would consider the solvent methyl ethyl ketone to be substantially different from the claim element acetone in this process.[5]

The lower court's holding is unique to the particular facts of this case. No "challenges [to] the very foundation of the doctrine of equivalents" have been made. Rather, the lower court's decision is mundane, holding simply that "the claim language itself, and the specification, suggest that substituting butanone for acetone is not an insubstantial change." Pet. App. at 13-14. Moreover, as also found by the Federal Circuit, "a review of the prosecution history by a competitor would reinforce the suggestion in the claim language and specification that using other ketone solvents, such as butanone, is not an insubstantial change from using acetone." Pet. App. at 14. The decision below is correct. No "counter-presumption" has been created by the lower court.

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[5] "Methyl ethyl ketone" is another name for "butanone".

Even if the lower court's decision were incorrect (which it most definitely is not), at best petitioners are urging that the lower court misapplied a properly stated rule of law. Thus, there are *no compelling reasons* for this Court to grant certiorari.

I. THERE IS NO CONFLICT BETWEEN THIS COURT'S DECISION IN *WARNER-JENKINSON* AND THE DECISION OF THE COURT OF APPEALS

1. *Warner-Jenkinson* establishes that a patentee bears the burden of explaining the reason for an amendment to a claim during prosecution. 117 S. Ct. at 1051. Where no explanation is forthcoming, a presumption of estoppel arises. *Id.* Here, there was no amendment during prosecution. However, it has long been the law that when an invention is characterized narrowly, as when a narrow claim is presented, or arguments or amendments narrowing the scope have been made, the scope of the claim may not be enlarged using the doctrine of equivalents. *Southwall Tech., Inc. v. Cardinal IG, Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995), cert. denied, ___ U.S. ___, 116 S. Ct. 515 (1995). In other words, a patentee is not permitted to present a narrow claim for examination to the PTO and once allowed, urge a broader scope under the doctrine of equivalents. *Genentech, Inc. v. Wellcome Found., Ltd.*, 29 F.3d 1555, 1568, fn.41 (Fed. Cir. 1994). *See* also *Sage Products, Inc. v. Devon Industries, Inc.*, 44 U.S.P.Q.2d (BNA), 1103, 1107 (Fed. Cir. 1997). *Warner-Jenkinson* did not address, much less change, the law regarding narrow claiming. Nor did *Warner-Jenkinson* address the factual situation present here, i.e., the intentional and specific exclusion of certain elements from the original claim, coupled with an attempt to capture those specifically excluded elements under the doctrine of equivalents.

As recognized by this Court in *Warner-Jenkinson*, "the doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement." 117 S. Ct. at 1049. Here the lower court simply found that applying the doctrine of equivalents broadly enough to cover the use of butanone would be to impermissibly allow "such broad play as to effectively eliminate that element [acetone] in its entirety." *See Warner-Jenkinson*, 117 S. Ct. at 1049. The lower court found significant the fact that Tanabe specifically claimed the use as a solvent of but one ketone, acetone, while simultaneously claiming the use as a solvent of a whole host of acetates, "lower alkyl acetates." Pet. App. at 13. Such specificity on the one hand, coupled with the more generic disclosure on the other hand, led the lower court to reason that those of skill in the art would conclude that other ketones were not interchangeable with acetone in this process. *Id.* Acetone was therefore found to be a "meaningful limitation," which could not be expanded so broadly as to cover butanone, because to do so would effectively eliminate the meaningful limitation in its entirety. There is no error in the lower court's reasoning.

The lower court's determination of the permissible range of equivalents is consistent with earlier decisions on this issue. Moreover, the Federal Circuit recently reaffirmed the long-standing principle that "where a patentee has claimed an invention narrowly, there may not be infringement under the doctrine of equivalents in many cases, even though the patentee might have been able to claim more broadly."[6] *Sage Products, Inc. v. Devon Industries, Inc.*, ___ F.3d ___, 44 U.S.P.Q.2d

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[6] Here, of course, Tanabe could not have claimed its alleged invention more broadly, because even its narrow claims were found to be obvious over the prior art and therefore invalid. Conclusion of Law 2, Pet. App. at 430.

1103 (Fed. Cir. 1997). Here, Tanabe claimed its alleged invention narrowly even though it might have been able to claim more broadly. Thus, there may not be infringement under the doctrine of equivalents, because to so find would be to do away with "the definitional and public notice functions" of the claim. *See Warner-Jenkinson*, 117 S. Ct. at 1049.

Like *Sage*, in this case the range of equivalents is restricted as a matter of law. The claim at issue here defines a relatively simple chemical process. *See*, *Sage* at 1107 (relatively simple product). A skilled patent drafter would foresee the limiting potential of the "acetone" limitation. *Id.* No subtlety of language or complexity of the technology, nor any subsequent change in the state of the art, such as later-developed technology, obfuscated the significance of this limitation [acetone] at the time of its incorporation into the claim. Methyl ethyl ketone was well known at the time Tanabe filed its patent application. *See, e.g., Penwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 938 (Fed. Cir. 1987) (in banc), cert. denied, 485 U.S. 961 (1988) ("[T]he facts here do not involve later-developed . . . technology which should be deemed within the scope of the claims to avoid the pirating of the invention.").

Had Tanabe desired broad patent protection for the use of any solvent that performed a function similar to the claimed solvent acetone, it could have sought claims using the phrase "solvent" or "lower alkyl ketones." *See Sage* at 1107. It did not. Instead, as the Federal Circuit properly held, Tanabe, like *Sage*, "left the PTO with manifestly limited claims that it now seeks to expand through the doctrine of equivalents." *Id.* By choosing to use the claim element "acetone" as opposed to a phrase like "lower alkyl ketones" while simultaneously employing the broader claim element "lower alkyl acetates," Tanabe told the world that it was specifically excluding other ketones (like butanone) from its claim. Therefore, the lower

court properly determined that butanone could not be encompassed within the permissible range of equivalents. *See Dolly, Inc. v. Spalding & Evenflo Cos.*, 16 F.3d 394, 400 (Fed. Cir. 1994). ("[T]he concept of equivalency cannot embrace a structure that is specifically excluded from the scope of the claims"). The lower court did not, and did not need to, inquire into the reasons for Tanabe's specific exclusion.

As between the patentee (Tanabe) who had a clear opportunity to negotiate broader claims but did not do so, and the public at large (including respondents), it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed process. *Sage*, at 1107-8.

> Because the doctrine of equivalents blurs the line of demarcation between infringing and non-infringing activity, it creates a zone of uncertainty, into which competitors tread only at their peril. *Cf. Markman v. Westview Instruments*, Inc., ____ U.S. ____, 134 L.Ed. 2d 577, 116 S. Ct. 1384, 1396 (1996) (discussing the importance of certainty in defining the scope of exclusive rights). Given a choice of imposing the higher costs of careful prosecution on patentees, or imposing the costs of foreclosed business activity on the public at large, this court believes the costs are properly imposed on the group best positioned to determine whether or not a particular invention warrants investment at a higher level, that is, the patentees.

Sage at 1107. *Cf. Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1108 (Fed. Cir. 1996), *cert. denied*, 117 S. Ct. 1244 (1997) (discussing danger of allowing a patentee to file and prosecute narrow claims and then, during the course of the litigation, expand its exclusive rights under the doctrine of equivalents, thereby avoiding examination of the broad subject matter).

Like the patent at issue in *Sage*, the '035 patent contains clear limitations and the public has a right to rely on those limitations in conducting its business activities. *Sage* at 14. ("If it were otherwise, then claims would be . . . devoid of meaningful . . . limitations on which the public could rely"). *See*, also, *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556, 1562, (Fed. Cir. 1994) ("The doctrine of equivalents cannot be used to erase 'meaningful structural and functional limitations of the claim on which the public is entitled to rely in avoiding infringement.'" (internal citations omitted))". Here, as held below, the public is entitled to rely on the meaningful limitation "acetone."

Thus, the Federal Circuit did not run astray of well established law in its decision. Rather, the decision below is consistent with that law. Petitioners' state that this Court recently reaffirmed that the test of equivalency is an "objective," "intent-neutral" standard, focused on whether the accused element is "substantially the same" as the element claimed in the patented process. Petition, at 12. The lower court applied just such a test, affirming the determination of the ITC that the patentee's actions are evidence supporting the conclusion that those of skill in the art, in view of the specificity of the claim language, the specification and the prosecution history, would not consider other ketones (including butanone), to be substantially the same as the element (acetone) claimed in the patented process.

2. Since prosecution history estoppel was not the basis for the lower court's holding, Section 2 of the Petition, which discusses this issue, is largely irrelevant. Petitioners imply that the omission from the claim of the use of the other ketones or, indeed, other solvents, was for reasons "unrelated to patentability." (Petition at 14). There is no basis in the record

for this assertion.[7] Petitioners confuse prosecution history estoppel, which is not at issue here, with the doctrine of narrow claiming, which is the basis for the decision below. That doctrine precludes a patentee from presenting narrow, specific, claims for examination and then attempting to expand the scope of those narrow claims under the doctrine of equivalents to capture what might have been claimed but was not. See *Sage* at 1107. ("As between the patentee (Tanabe) who had a clear opportunity to negotiate broader claims but did not do so, and the public at large (including respondents), it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed process").

3. Respondents agree that the lower court exhaustively analyzed the record but disagree with petitioners' argument that the court did so "*to establish* that Tanabe consistently . . . claimed only 'specific base-solvent combinations'." The lower court undertook its exhaustive analysis to determine whether *or not* Tanabe was precluded as a matter of law, by the doctrine of narrow claiming, from expanding its claim scope under the doctrine of equivalents to capture what it might originally have been able to claim, *See Sage* at 1107, ("There may not be infringement under the doctrine of equivalents in many cases even though the patentee might have been able to claim more broadly.") and to determine whether substantial evidence supported the ITC's determination. The result of the lower court's analysis is not a "new limitation" on the doctrine of equivalents but rather a fair and just determination of the proper

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[7] Indeed, in the underlying proceeding petitioners were sanctioned by ALJ Harris because numerous Tanabe witnesses including the inventors refused to answer deposition questions. Pet. App. at 3, fn. 2 and Order No. 52. Perhaps, had those witnesses answered questions, the true "reasons" for the claim specificity would have emerged.

scope of *this* claim under the doctrine of equivalents in view of *these particular facts*.

4. The lower court did not engage in "an expansion of prosecution history estoppel." Under the petitioner's theory of the doctrine of equivalents, a patentee would never have to provide fair notice to the public concerning the scope of a patent's claim. ALJ Harris, the ITC and the lower court each properly rejected that theory. More fundamentally, the lower court simply concluded on the record before it that because Tanabe specifically excluded other ketones such as butanone from the claim, it could not capture those ketones under the doctrine of equivalents. That conclusion is correct.

5. Petitioners urge the existence of an "overarching flaw" in the lower court's decision. Petition at 18. No flaw exists. Petitioners' premise is founded upon the fundamental error that butanone *is* equivalent in the claimed process to acetone, that this equivalence was not recognized by Tanabe at the time it filed its patent application, and that the lower court is somehow penalizing Tanabe for its failure of recognition. Even if all of this were true, which it is not, this is not the sort of "compelling reason" warranting review by this Court. The lower court simply gave weight to the claim element acetone, refusing to eliminate that element in its entirety through the doctrine of equivalents. That refusal was justified. *See, Warner-Jenkinson*, 117 S. Ct. at 1049. Moreover, the lower court found that substantial evidence supported the ITC's determination that butanone and acetone are substantially different, i.e. *not* equivalent. Pet. App. at 18.

Petitioners also assert here that the lower court denied "the doctrine's application to a patentee due to his failure to claim the element in his patent claim because he did not know of its equivalence at the time of procurement." Petition at 19. This assertion is without a basis on the record. First, there is no

record evidence indicating what Tanabe regarded as equivalent at the time of the patent application. Second, the court did not make such a holding. Rather, the court considered the fact that ordinarily those of skill in the art might consider the interchangeability of these two solvents and concluded that Tanabe's presentation of a narrow claim specifically excluding other ketones should be considered in determining the appropriate scope of equivalents.

6. Struggling to fit a square peg into a round hole, the petition contains a lengthy recitation of the facts of *Warner-Jenkinson*. Those facts are not the facts here. Unlike *Warner-Jenkinson*, here, with respect to one of the claimed elements, Tanabe included a *range* of solvents of a particular type, "lower alkyl acetates," while specifically excluding all ketones but one, acetone. In *Warner-Jenkinson*, no such distinction was made. Moreover here, unlike *Warner-Jenkinson*, petitioners were found not to have demonstrated the objective equivalency of acetone and butanone in this process. Pet. App. at 18. Thus, the *Warner-Jenkinson* test has been satisfied.

II. AS THERE IS NO CONFLICT BETWEEN THIS CASE AND *WARNER-JENKINSON*, THIS COURT SHOULD DENY THE PETITION FOR CERTIORARI.

Petitioners mistakenly conclude that the lower court created a "new form of estoppel," which is in conflict with this Court's holding in *Warner-Jenkinson*. Petition at 25. No estoppel was found by the lower court. There has always been a boundary beyond which the scope of a patent claim may not be enlarged under the doctrine of equivalents. Otherwise, "the definitional and public-notice functions of the statutory claiming requirement" would be undone. *Warner-Jenkinson*, 117 S. Ct. at 1049. Petitioners sought to have the lower tribunal read acetone entirely out of the claim, asserting in the

underlying proceeding that "any solvent" that would work would be equivalent. ALJ Harris found petitioners' position untenable and the lower court, based upon the record before it, quite properly determined that "acetone" was a meaningful claim limitation and held that, the patentee having specifically excluded other ketones from the claim, it could not now erase that limitation through the doctrine of equivalents. Petitioners point to no error of the lower court, based upon the record. That petitioners may not agree with, or like, the lower court's decision does not make it "bizarre" or "unworkable" (Petition at 25) and certainly provides no *compelling reason* for granting a writ of certiorari.

The Federal Circuit created no "counter-presumption" (Petition at 25). While the petition uses the term, the Federal Circuit did not. Petitioners' alleged concerns regarding the effects of this decision on future jury trials in unrelated matters is purely speculative. The holding is clearly limited to the claim at issue, and to the facts of this case. If similar facts arise in future cases, then and only then might the lower court's decision have an effect, but that effect would be beneficial, not "untoward." There is simply no valid reason to believe that *any* untoward effects on future jury trials will be felt.

The decision below does not even address, much less "raise again," the question of whether judges or juries are tasked with the responsibility of applying the doctrine of equivalents. This case arose from the ITC, where there is no jury. Petitioners simply seek to expand the lower court's decision beyond its proper boundaries, not unlike the expansion they seek for their claim, in order to create something which they can turn around and attack.

Petitioners have absolutely no basis for suggesting that the lower court did not consider the *Warner-Jenkinson* decision. The lower court's opinion specifically cites *Warner-Jenkinson*

not once, but twice [8]. Petitioners specifically brought *Warner-Jenkinson* to the lower court's attention again with their request for reconsideration, which was denied. Further, there are subsequent decisions by the same lower court affirming the very doctrine of narrow claiming at issue here.

It is unthinkable that the lower court did not fully consider *Warner-Jenkinson*, one of the most awaited opinions in the annals of patent law, and there simply is no basis for petitioners' suggestion. The fact that it is cited not once, but twice, demonstrates unequivocally that the lower court was aware of this Court's opinion. Thus, *Warner-Jenkinson* is *not* an "intervening" event requiring reconsideration. All that the lower court's decision has done is uphold the longstanding principle that where a patentee claims narrowly, the cost of that choice must be borne by the patentee rather than by the public who has a right to rely upon the fair notice provided by the claims. *See Warner-Jenkinson*, 117 S. Ct. at 1049.

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[8] The petitioner incorrectly states that there is but a single reference in the lower court's opinion to *Warner-Jenkinson*. Petition at 28. There are two. Pet. App. at 6 and 12.

CONCLUSION

It is respectfully submitted that there is no compelling reason warranting a grant of a writ of certiorari by this Court. Accordingly, for the reasons set forth above, Tanabe/MMD's petition should be denied.

Respectfully submitted,

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